



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant : Marvin K. Simon et al. Art Unit: Unknown  
Serial No.: 09/496,135 Examiner: Unknown  
Filed : February 1, 2000  
Title : CROSS CORRELATED TRELLIS CODED QUADRATURE  
MODULATION TRANSMITTER AND SYSTEM

Commissioner for Patents  
Washington, D.C. 20231

PETITION FOR ACCEPTANCE OF APPLICATION UNDER RULE 47(B)

-INVENTOR REFUSES TO SIGN-

Sir:

Kindly accept the above-referenced application under 47(b).  
The inventors have refused to sign this application.

The facts are as follows. All of the facts stated below  
are from the personal knowledge of the undersigned. A  
declaration affirming these facts will be provided if believed  
necessary by the patent office.

The undersigned personally worked with one of the  
inventors, Marvin Simon, in preparation of this case. Dr. Simon  
was satisfied, generally, with the contents of the case.

06/28/2000 MGORDON 00000048 061050 09496135

01 FC:122 130.00 CH

CERTIFICATE OF MAILING BY FIRST CLASS MAIL

I hereby certify that this correspondence is being deposited with the  
United States Postal Service as first class mail with sufficient postage on  
the date indicated below and is addressed to the Commissioner for  
Patents, Washington, D.C. 20231.

June 9, 2000

Date of Deposit

Signature

Roxanne Ippolito

Typed or Printed Name of Person Signing Certificate

However, Dr. Simon was extremelly particular about the form of the equations. Dr. Simon asked that we proofread the equations again. We did so, and sent another copy to Dr. Simon. He responded with anger, admitting that the application was substantively correct, but unsatisfied with the form of the equations. For example, Dr. Simon complained that certain parts of certain equations should have been italicized, and were not.

We then responded by having paralegals proofread these equations. The cost for these services was billed to the client. After about \$10K in billing, Dr. Simon again complained that the application still were not perfect. At that point, he refused to tell the undersigned what the imperfections were. The in house counsel for California Institute of Technology indicated that they were unwilling to spend more fees for proofreading the equations. I myself personally considered the content of these equations as compared to Dr.Simon's paper. I was unable to asertain the differences.

Dr. Simon was contacted to sign the application, and refused to do so. He stated simply that "the application did not meet with his approval". Based on the conversations that I had with Dr. Simon, it appears that he was completely satified with the contents, but that the form still did not meet with his approval. We continued to attempt to obtain his signature for

close to a year. In fact, we used our entire four month extension in a parent case, in response to a Notice to File Missing Parts, and was still unable to obtain his signature.

Dr. Yan works with Dr. Simon, and I have no explanation for why Dr. Yan will not sign the application. I have faxed him the application and papers, and he has never returned the signed papers.

Hence, the inventors refuse to sign this application.

Both of the inventors are government employees working for Jet Propulsion Laboratories, which is run by a government contractor: California Institute of Technology. As government employees, they have obligation to sign patent applications made within the scope of their work, which this one obviously was. The patent agreement that was signed by Dr. Simon is attached.

A declaration signed by a representative of California Institute of Technology will be filed in due course.


Please charge the rule 17(i) fee of \$130 to deposit account no. 06-1050.

A notice that the petition has been excepted is  
respectfully solicited.

Respectfully submitted,

Date: \_\_\_\_\_

6/9/00

  
\_\_\_\_\_  
Scott C. Harris  
Reg. No. 32,030

Fish & Richardson P.C.  
Customer Number: 20985  
4350 La Jolla Village Drive, Suite 500  
San Diego, CA 92122  
Telephone: (858) 678-5070  
Facsimile: (858) 678-5099



## POLICY - PATENT AGREEMENT

JPL  
JPL PROPELLION LABORATORY  
California Institute of Technology  
4800 Oak Grove Dr., Pasadena, Calif. 91103

**INSTITUTE PATENT POLICY:** Certain of the inventions made by employees in line of duty or with the use of Institute facilities will be patented in order to protect the Institute and the public. These patents will be assigned to the Institute, or its nominee, and all costs involved in obtaining patents borne by the assignee.

The Institute Patent Agreement is included here for your information and all employees are required to sign it upon employment.

Inventors will receive a proportion of royalty income accruing from patent properties in accordance with the established and announced patent policy in force at the date of signing of the Institute Patent Agreement.

Inventions and discoveries made by an employee on his own time and without the aid of Institute facilities are the sole property of the inventor.

## PATENT AGREEMENT

WHEREAS, the California Institute of Technology, a California corporation (hereinafter referred to as "the Institute"), has certain responsibilities to see that inventions made at the Institute be administered for the best interests of the public and of the Institute; and in accordance with its contractual agreements with sponsors of research at the Institute;

THEREFORE, by this agreement, executed by me and accepted by the Institute, I hereby promise and agree as follows:

I will notify the Institute promptly of any discovery, innovation or invention (hereinafter all designated "invention") which might possibly be patentable and which is made in the course of my duties at the Institute, or with the use of Institute facilities. At the request of the Institute or its nominee, I will assign to the Institute or its nominee all patent rights I may have to any such invention in the United States and foreign countries. I will supply all information and execute all papers necessary for the purpose of prosecuting patent applications on such inventions. Expenses for such patent applications shall be borne entirely by the Institute or its nominee. I understand that the Institute reserves the right to abandon the prosecution of any patent applications.

Furthermore, I will disclose promptly and fully to the Institute all matters, whether patentable or not, that I may solely, or jointly with others, develop wholly or partly in the course of any work in which I may engage covered by any contract between the Institute and others (including the

United States government). If called upon, I will execute all documents and supply all information which the Institute or its nominee deems necessary or desirable in order to perform its patent obligations under any such contract.

It is understood as a part of this agreement that if the Institute receives revenue from patents on inventions assigned to it by me pursuant to this agreement, I shall share in these funds according to the established and announced patent policy of the Institute in force at the date of this agreement.

This agreement is made in consideration of my employment by the Institute, in consideration of the continuance of my employment and of future employment, and for other valuable consideration.

It is further understood that this agreement is part of the terms of my employment, and any contract of employment heretofore or hereafter entered into between me and the Institute shall be deemed to include this agreement except to the extent that an express provision of such contract of employment is inconsistent therewith.

It is further understood that performance on my part of the terms of this agreement is one of the purposes for which I am employed and that such performance will be taken into consideration and relied upon by the Institute in making decisions as to the assignment of work to me.

It is further understood that the Institute may and will rely upon the foregoing agreement in making contracts with others in which the Institute may undertake obligation, with respect to discoveries made by its employees.

ACCEPTED:

CALIFORNIA INSTITUTE OF TECHNOLOGY

By

DATED: Mar 8 1980

Name (Print)

Signature

**Institute Patent Policy:** Certain inventions which may be made by employees in line of duty or with the use of Institute facilities should be patented in order to protect the Institute and the public. These patents should be assigned to the Institute and all costs involved in obtaining the patents borne by the Institute.

In general, no revenue in excess of costs should be received from such patents. However, in those cases when excess revenue does accrue, the inventor should then receive fifteen per cent (15%) of the gross accrual.

Inventions and discoveries made by an employee on his own time and without the aid of Institute facilities are the sole property of the inventor.

The Institute Patent Agreement is included here for your information as all employees are required to sign it upon employment.

### PATENT AGREEMENT

WHEREAS, the California Institute of Technology, a California corporation (herein referred to as "the Institute"), has certain responsibilities to see that inventions made at the Institute be administered for the best interests of the public, and in such a way as to avoid any criticism of the Institute:

THEREFORE, by this agreement, executed by me and accepted by the Institute, I hereby promise and agree as follows:

I will notify the Institute (or any individual, corporation or governmental agency which the Institute may specify) promptly of any invention which I believe to be patentable and which is made in the course of my duties at the Institute, or with the use of Institute facilities. At the request of the Institute or its nominee, I will assign to the Institute or its nominee all patent rights I may have to any such invention in the United States and foreign countries. I will supply all information and execute all papers necessary for the purpose of prosecuting patent applications on such inventions. Expenses for such patent applications shall be borne entirely by the Institute or its nominee. I understand that the Institute reserves the right to abandon the prosecution of any patent applications. Furthermore, I will disclose promptly and fully to the Institute all matters, whether patentable or not, that I may solely, or jointly with others, develop wholly or partly in the course of any work in which I may engage covered by any contract between the Institute and others (including the United States government). If called upon, I will execute all documents and supply all information which the Institute or its nominee

deems necessary or desirable in order to perform its patent obligations under any such contract.

It is understood as a part of this agreement that if the Institute receives revenue from patents on inventions assigned to it by me pursuant to this agreement in excess of administrative costs I shall share in these funds according to the established and announced patent policy of the Institute in force at the date of this agreement.

The foregoing agreement is made in consideration of my employment by the Institute, in consideration of the continuance of my employment and of future employment, and for other valuable consideration.

It is further understood that the foregoing agreement is part of the terms of my employment, and any contract of employment heretofore or hereafter entered into between me and the Institute shall be deemed to include the foregoing agreement except to the extent that an express provision of such contract of employment is inconsistent therewith.

It is further understood that performance on my part of the foregoing agreement is one of the purposes for which I am employed and that such agreement will be taken into consideration and relied upon by the Institute in making decisions as to the assignment of work to me.

It is further understood that the Institute may and will rely upon the foregoing agreement in making contracts with others in which the Institute may undertake obligations with respect to discoveries made by its employees.

ACCEPTED:

CALIFORNIA INSTITUTE OF TECHNOLOGY

By: 

DATED: 5/23, 1969

Name (Print) MARVIN KENNETH SIMON

Signature 